REMARKS

Claims 1 to 17 are now pending and being considered.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph three (3), claims 1, 2 to 8, 9, 10 to 16, and 17 were rejected under the first paragraph of 35 U.S.C. § 112 as to the written description requirement.

The specification specifically discloses the feature of "standard health promotion details" at page 10, line 7, and the feature of "health promotion information is standardized" at page 19, lines 13 and 14. Therefore, "standardized health promotion information" is included in the original disclosure. Also, the specification discloses the feature of "standardized scenario including health promotion information and health promotion timing" at page 3, lines 9 to 11. This disclosure of "standard health promotion details" at page 10, line 7, the paragraph at page 3, lines 7 to 14, and Figure 4 plainly disclose the feature of "standardized health promotion timing". It is therefore respectfully requested that the written description rejections be withdrawn for these reasons alone.

Still further, to the extent that new matter objection is maintained, it is respectfully submitted that the Final Office Action reflects a literalistic and therefore "in haec verba" view of the "new matter" doctrine that is simply inconsistent with to the relevant law defining that doctrine. In the case of *Chemcast Corp. v. Arco Ind. Corp.*, 5 U.S.P.Q..2d 1225, 1237 (E.D. Mich. 1987), for example, the court made plain that:

> New matter is matter involving a departure from or in addition to the original disclosure, 37 CFR §1.118. . . . *New matter is not introduced by amendments . . . which merely clarify or make definite that which was expressly or inherently disclosed in the parent application* or which conform the specification to matter originally disclosed in the drawings or claims. . . . *Added subject matter is not new matter when it is "something that might fairly be deduced from the original application."*

(Quoting *Stearn v. Superior Distributing Co* ., 674 F.2d 539, 544, 215 U.S.P.Q. 1089, 1093 (6th Cir. 1982) (citations omitted)).

Accordingly, in the present case, where there is plain and unequivocal support in the present application, as explained above, the claim feature at issue ("standardized health promotion information and standardized health promotion timing") cannot and does not represent new matter, in view of the foregoing.

It is respectfully submitted that the written description requirement is satisfied for the same reasons explained above that the claim feature at issue is not new matter and is supported by the present application. It is therefore respectfully requested that the written description rejections be withdrawn for the foregoing reasons.

With respect to paragraph six (6), claims 1 to 3, 7, 9 to 11, 15 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,207,580 ("Strecher") in view of "Cairnes", U.S. Patent No. 6,139,494..

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Final Office Action interprets Cairnes' statement of "providing clinical communications and information that meet quantitative and qualitative standards" (column 2, lines 32-34) and "a preferred embodiment of the present invention may recommend therapies according to standards set by a particular national medical organization and/or institute" (column 7, line 64 to column 8, line 1) as teaching a form of storing standardized scenarios. Item 458 in Fig. 10 assertedly concerns a database of "what to do in case of", which is accessed via a Medical Library Menu.

Even if Cairnes assertedly suggest outputting some therapies based on standards, it does not in any way disclose or suggest the standardized scenario that is used for preparing a health promotion schedule with the data that is obtained by the obtaining part, as provided for in the context of the independent claims. The "standardized" statements of Cairnes (as asserted by the Final Office Action) do not in any way concern or relate to the "scenario" feature used for preparing a health promotion schedule, as provided for in the context of each of the independent claims.

In the Final Office Action, it mentions that the remaining claims are rejected for the same reason given in the prior Office Action. In the prior office action, it equates "outpatient case summaries" with "scenarios", but the prior Office Action does not in any way indicate that "outpatient case summaries" are standardized in the Final Office Action.

In the prior office action, the assertions (which was not agreed with) for "a reading operation", "a preparing operation" and "an outputting operation" is based on "outpatient case summaries" as read on "scenarios". Therefore, if the Office asserts that the features (Item 458 in Fig. 10, for example) pointed out in this office action, instead of the "outpatient case summaries", correspond to the claimed "standardized scenario", then the Office must explain why the features of a "reading operation", a "preparing operation" and an "outputting operation", based on the features (Item 458 in Fig. 10, for example) pointed out in the Final Office Action to reject the independent claims, and their respective dependent claims.

Also, as previously explained in the prior response the following is submitted:

The Office Action asserts that in "Strecher" the collecting of data "about the pattern and history of the health-related behavior" corresponds to a "scenario" (citing column 4, lines 5 to 27) , and further asserts that the pattern and history data are collected by questioning the user (citing column 3, lines 14 to 26).

In the context of the presently claimed subject matter, as presented, the health promotion practitioner support apparatus includes a "storing part" to store the scenarios, an "obtaining part" to obtain data on lifestyles and the level of readiness for change of a client, and a "preparing part" to prepare a health promotion schedule of the client using the scenario that is read from the "storing part" and the data that is obtained by the "obtaining part".

In particular, as presented, claim 1 provides for a storing part storing *scenarios each of which is standardized and* includes *standardized health promotion information and standardized health promotion timing for each of levels of readiness for change*, an obtaining part obtaining data on lifestyles and said level of readiness for change of a client, a part preparing a health promotion schedule of said client using from said scenario that is read from said storing part and said data that is obtained by said obtaining part, and outputting said health promotion schedule, and a part outputting health promotion information for said client according to operation to said health promotion schedule.

The Office Action cited the secondary "Cairnes" reference for "reading a scenario from a storing part". The Office Action equates the "outpatient case summary" with the scenario, and equates "database 130" with the storing part. However, the database 130 stores outpatient data based on medical information received from each patient (Fig. 11, for example). The "case summary" appears to be for each patient (column 15/line 47-52). Therefore, it is apparent that the outpatient case summary read from the database 130 does not include "standardized" information, but includes information for each patient.

Accordingly, the "Cairnes" reference does not disclose or suggest the feature of reading a scenario which is standardized and includes standardized health promotion information and standardized health promotion timing.

Also, "Strecher" does not suggest such scenario. In this regard (even accepting the assertions of the Office Action for purposes of this response), the "Strecher" reference apparently only refers to "obtaining" such data – *but the "Strecher" reference does not in any way disclose or even suggest the "preparing part" for preparing a health promotion schedule using both the obtained data and the scenario, as provided for in the context of the subject matter of claim 1.*

The reference does not disclose the use of scenarios, as provided for in the context of the claimed subject matter. In particular claim 1, as presented, requires the storing of *scenarios each of which is* <u>*standardized*</u> and includes <u>*standardized*</u> *health promotion information* and <u>*standardized*</u> *health promotion timing* for each of levels of readiness of change., and the preparing of a health promotion schedule of the client from the scenario and the obtained data. A review of the text cited in the Office Action provides no real support for the assertions of the Office Actions to date as to the presently claimed subject matter of claim 1 as presented.

As further regards the obviousness rejections, it is respectfully submitted that the cases of <u>In re Fine</u>, <u>supra</u>, and <u>In re Jones</u>, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify the reference does not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of <u>In re Fine</u> stated that:

> The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .
>
> **Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

> Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .
>
> **Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original). Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" — which is not the case here — there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

> In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there

> was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). As referred to above, any review of the reference makes plain that the reference simply does not describe the features discussed above of the rejected claims.

It is therefore respectfully submitted that claim 1 is allowable for these reasons.

Claims 9 and 17, as presented, include features like those of claim 1 and are therefore allowable for essentially the same reasons as claim 1.

Claims 2 to 8 depend from claim 1, and are therefore allowable at least for the same reasons as claim 1. Claims 10 to 16 depend from claim 9, and are therefore allowable at least for the same reasons as claim 9.

It is therefore respectfully submitted that claims 1 to 17 are allowable, and that the obviousness rejections of the claims should be withdrawn.

With respect to paragraph seven (7), claims 4 and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over the "Strecher" reference in view of "Cairnes", U.S. Patent No. 6,139,494, and in view of the Reiger article.

Claim 4 depends from allowable claim 1. It is therefore respectfully requested that the obviousness rejections be withdrawn since claim 4 is allowable for essentially the same reasons as claim 1, and since the "Rieger" reference does not cure the critical deficiencies of the "Strecher" and "Cairnes" references, which were explained above. This is because any review of the third-level "Rieger" reference makes clear that it simply does not in any way disclose or suggest the claim 1 features, as explained above. Accordingly, claim 4 is allowable.

Claim 12 depends from allowable claim 9. It is therefore respectfully requested that the obviousness rejections be withdrawn since claim 12 is allowable for essentially the same reasons as claim 9, and since the third-level "Rieger" reference does not cure the critical deficiencies of the "Strecher" and "Cairnes" references, which were explained above. This is because any review of the secondary "Rieger" reference makes clear that it simply does not

in any way disclose or suggest the claim 9 features, as explained above. Accordingly, claim 12 is allowable.

With respect to paragraph eight (8), claims 5, 6, 8, 13, 14 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over the "Strecher" reference in view "Cairnes", and in further view of U.S. Patent No. 6,039,688 ("Douglass").

Claims 5, 6 and 8 depend from allowable claim 1. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 5, 6 and 8 are allowable for essentially the same reasons as claim 1, and since the "Douglass" reference does not cure the critical deficiencies of the "Strecher" and "Cairnes" references, which were explained above. This is because any review of the third-level "Douglass" reference makes clear that it simply does not in any way disclose or suggest the features of claim 1, as explained above. Accordingly, claims 5, 6 and 8 are allowable.

Claims 13, 14 and 16 depend from allowable claim 9. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 13, 14 and 16 are allowable for essentially the same reasons as claim 9, and since the "Douglass" reference does not cure the critical deficiencies of the "Strecher" and "Cairnes" references, which were explained above. This is because any review of the third-level "Douglass" reference makes clear that it simply does not in any way disclose or suggest the features of claim 9, as explained above. Accordingly, claims 13, 14 and 16 are allowable.

It is therefore respectfully submitted that claims 1 to 17 are allowable.

Conclusion

It is therefore respectfully submitted that all of claims 1 to 17 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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By: _____
Aaron C. Deditch
Reg. No. 33,865

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

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